

BASIS FOR THE AMENDMENT

Claims 1-30 are active in the present application. Claim 1 has been amended to include the transitional phrase “comprises”. The transitional phrase “consisting of” now appear in dependent Claim 28. The claims have been amended to remove improper multiple dependencies. Claims 23-30 are new claims. Support for new Claim 23 is found in the last paragraph on page 18. Support for new Claim 24 is found on page 19, third paragraph. Support for new Claim 25 is found on page 19, fifth paragraph. Support for new Claim 26 is found on pages 21 and 22. Support for new Claim 28 is found on page 5, lines 14-27 and Example 1. Support for new Claims 29 and 30 is found in the Examples. No new matter is believed to have been added by this amendment.

REQUEST FOR RECONSIDERATION

Applicants thank Examiner Khan for the helpful and courteous discussion of October 5, 2005. One point covered during the discussion was the cited prior art's description of a polymer-type material that excludes methyl(meth)acrylate. Applicants representative noted the prior art relied upon by the Office in the Office Action of August 18, 2005 does not disclose a functional fluid containing a polymer having methyl(meth)acrylate in an amount of from 34 to 90 wt%.

At the outset, Applicants note that the presently claimed invention is drawn to a "functional fluid" (see preamble of Claim 1). In contrast, the cited prior art (i.e., Liesen) discloses an alkyl(meth)acrylate copolymer (see paragraph [0008]).

The presently claimed invention is drawn to a functional fluid that may be used in applications such as lubricating fluids. Conventional lubricating fluids have been burdened with the undesirable flammability characteristics associated with the low molecular weight additives present therein. In contrast to the problems associated with conventional lubricating fluids, the claimed invention is able to provide good viscosity and good pour point properties while maintaining excellent fire resistance. The invention functional fluid may provide improved flame resistance without sacrificing viscosity properties.

The Office rejected the originally presented claims as anticipated by a published U.S. application to Liesen (U.S. 2004/0092409). The Office asserts that Liesen discloses alkyl(meth)acrylate copolymers and their use in a variety of base oils. Applicants note that Liesen's description of the prior art invention excludes methyl(meth)acrylate from the prior art copolymer. In fact, Liesen explicitly discloses that methyl(meth)acrylate is excluded from the invention of the published application (see for example paragraphs [0003]; [0004]; [0007]; [0027]; [0028]; and [0044]).

Applicants submit that the presently claimed invention which requires the presence of an alkyl(meth)acrylate cannot be anticipated by Liesen because Liesen does not disclose an inventive composition which contains the alkyl(meth)acrylate polymer of present Claim 1 (e.g., one that includes methyl(meth)acrylate) in combination with one or more of the oxygen-containing compounds also recited in present Claim 1. Applicants respectfully request the withdrawal of the rejection.

Applicants further submit that Liesen cannot render the presently claimed invention obvious in view of Liesen's explicit contradictory disclosure with respect to the exclusion of methyl(meth)acrylate in the prior art inventive compositions. Applicants submit that those of ordinary skill in the art would have no motivation to prepare the presently claimed compositions from the disclosure of Liesen discloses an invention that excludes methyl(meth)acrylate whereas present Claim 1 explicitly requires an alkyl(meth)acrylate polymer (i.e., "1 to 99 % by weight based on the total weight of the functional fluid of alkyl(meth)acrylate polymers").

Although Liesen discloses a comparative example that may include a copolymer of methyl(meth)acrylate (see Table 2), the prior art published application does not disclose that an additional oxygen-containing compound such as that recited in present Claim 1 must be present.

Applicants further draw the Office's attention to the subject matter of dependent Claim 23-27. New dependent Claims recite the particular kinematic viscosity and pour point, and fire resistance properties demonstrated in the examples of the present specification.

New Claim 27 requires the presence of a polymer having methyl(meth)acrylate in an amount of from 34-90 wt%. As was mentioned above, Liesen discloses an invention that explicitly excludes a methyl(meth)acrylate polymer. Applicants therefore submit that dependent Claim 27 is further patentable over the prior art relied upon by the Examiner.

Applicants draw the Office's attention to new dependent Claims 29 and 30 which recite a copolymer of a specific mixture of alkyl(meth)acrylate monomer species not disclosed in the cited prior art and particular oxygen-containing species, respectively.

Applicants submit that Claim 1 is novel and not obvious in view of the prior art relied upon by the Office and respectfully request withdrawal of the rejections.

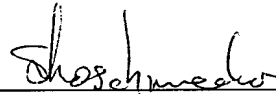
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